

REMARKS

This amendment is in response to the Non-Final Office Action of December 14, 2005.

Claims 1, 15, 28, 29 were rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Examiner is unclear as to what the multiple page dialog field is.

The Applicant amended claims 1 and 15 to address the Examiner's concerns: the phrase "comprises K pages for setting sound tone tasks" is added which clarifies that multiple page dialog field comprises K pages specifically related to "sound tasks". Claims 28 and 29 are cancelled because claims 28 and 29 are redundant to the content (i.e., the scope) of modified claims 1 and 15 (as discussed in more detail below).

The Examiner further pointed out in regard to claims 1 and 15 that the term "optionally" in line 6 and line 7, respectively, renders the claim indefinite because it is a term with alternate meaning. In context with claim 1, the term "optionally" is saying that there is a no-tone sound item but then there doesn't have to be. The applicant removed the word "optionally" from claims 1 and 15, thus eliminating indefiniteness referred to by the Examiner. The amended claims 1 and 15 are clarifying that:

*"said one page comprises at least two sound tone items out of:*

*a)  $N_i$  dedicated sound tone items with a predetermined purpose and presented only on said one page, and*

b) a no-tone sound item,".

Stating that there are at least "two sound tone items" does not create any new matter in claims 1 and 15 because it is already stated that  $N_i$  has at least a value of 2.

Moreover, the Examiner stated, regarding claim 2, that the term "optionally" in line 2 renders the claim indefinite because it is a term with alternate meaning. In response to the Examiner's remarks, the Applicant removes the whole embodiment related to the word "optionally" in claim 2 and added said embodiment in the dependent new claim 30 without using the word "optionally".

Furthermore, regarding claim 3, the Examiner stated that the term "optionally" in line 5 renders the claim indefinite because it is a term with alternate meaning. In context with claim 3, the term "optionally" is saying that there is a no-tone sound item but then there doesn't have to be. The Applicant removed the word "optionally" and amended claim 3 reciting the same limitations related to the further page as in claim 1.

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Claims 1, 11-16, 23-29 were rejected under 35 U.S.C. 102(b) Ito et al. (U.S. Pub 2001/0053692 A-1). The applicant believes that the Examiner's statements are not accurate and need further clarification.

The Examiner's arguments are analyzed based on MPEP guidelines which are stated in the MPEP Paragraph 2131 as follows:

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference."  
*Verdegaal Bros. V. Union Oil Co. of California*, 2 USPQ2d

1051, 1053 (Fed. Cir. 1987), MPEP 2131. Further, "the identical invention must be shown in as complete details as is contained in the . . . claim", *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989), MPEP 2131.

Regarding independent claims 1 and 15 of the present invention, the claims 1 and 15 state that the dedicated sound tone items with a predetermined purpose are only presented "on said one page". However, in case of Ito et al., the sound tone item "samba-sound" is presented on 2 pages: Figure 9c and 9d. Moreover, the items presented in Figures 6a or Figure 6b of Ito et al. have different purposes as far as sound tone is concerned and thus do not describe a limitation of claim 1 or 15 of the present invention stating that  $N_i$  dedicated sound tone items have a predetermined purpose, which is not recited by Ito et al. in regard to Figures 6a and 6b.

Therefore, the disclosure of Ito et al. does not read onto claims 1 and 15 of the present invention. Thus, Ito et al. do not describe all claim limitations of the independent claims 1 and 15 of the present invention required by the MPEP Rule 2131 quoted above, therefore, claims 1 and 15 are novel and are not anticipated by Ito et al. under 35 USC Section 102(b).

To even further clarify the difference between the present invention and the Ito et al. as explained above, the Applicant added in claims 1 and 15 the following clarifying statement which is supported by the claims 1 and 15 themselves and by the specification:

"wherein each of said K pages comprises at least two dedicated sound tone items, and all dedicated sound tone items presented on said each page have a unique

predetermined purpose presented only on said each page".

This statement clearly separates the present invention from the reference of Ito et al. Ito et al. describe only one page "with at least two dedicated sound tone items with a unique predetermined purpose presented only on said each page" as recited in claims 1 and 15 of the present invention. Figure 9(d) of Ito et al. is not qualified to be the second "sound" page because it contains only one sound tone (it should be at least two dedicated sound tone items according to amended claims 1 and 15). But even if there would be more than 2 sound tone items on Figure 9d of Ito et al., Figures 9c and 9d of Ito et al. would not disclose embodiments of claims 1 or 15 of the present invention because the sound tone items in figure 9d of Ito et al. do not have a "unique predetermined purpose presented only on said each page" as recited in modified claims 1 and 15 of the present invention. In other words, the sound tone items in figure 9d of Ito et al. are related to the one sound tone item in figure 9c selected for listing more options, which is different than described in claims 1 and 15 according to embodiments of the present invention.

Claims 28 and 29 are cancelled.

Claims 11-14, 16 and 23-27 are dependent claims of independent claims 1 or 15, respectively. Since independent claims 1 and 15 are not anticipated by Ito et al. under 35 USC Section 102(b), as shown above, dependent claims 11-14, 16 and 23-27 referred to corresponding novel independent claims 1 and 15 are also novel, and, therefore, they are not anticipated by Ito et al. under 35 USC 102(b).

*Furthermore, the Examiner did not present a sound proof of Ito et al. teaching further unique limitations*

*recited in dependent claims 11-14, 16 and 23-27 of the present invention, which still further reinforces their novelty.* Additional considerations can be presented by the Applicant regarding these unique limitations of claims 11-14, 16 and 23-27, if needed.

Thus, based on the above remarks, claims 1, 11-16 and 23-27 are not anticipated by Ito et al. under 35 U.S.C. 102(b).

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Claims 2-5, 7, 9-10, and 18-22 were rejected under 35 U.S.C. 103(a) as being unpatentable over Ito et al (U.S. Pub 2001/0053692 A-1).

Regarding claims 2-5, 7, 9-10, and 18-22, these are dependent claims (directly or indirectly) of independent claims 1 and 15. Independent claims 1 and 15 are not unpatentable over Ito et al., as shown above. Since each of the dependent claims 2-5, 7, 9-10, and 18-22 narrows the scope of the novel and non-obvious independent claims 1 and 15, non-obviousness of claims 1 and 15 will compel non-obviousness of claims 2-5, 7, 9-10, and 18-22.

Moreover, the applicant believes that the Examiner's statements are not accurate and need further clarification. The 35 U.S.C.103(a) rejection of claim 2-5, 7, 9-10, and 18-22 is analyzed using MPEP guidelines which are stated in the MPEP Paragraph 2143 as follows:

"To establish a *prima facie* case of obviousness three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation

of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in Applicant's disclosure. ***In re Vaeck***, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)."

First, Ito et al. does not teach or suggest all the limitations of independent claims 2-5, 7, 9-10, and 18-22 as required by the MPEP Paragraph 2143 to establish a *prima facie* case of obviousness. Just to say "it is obvious" or it is obvious to the Examiner" does not describe the limitations of each of the corresponding claims 2-5, 7, 9-10, and 18-22, as required by the MPEP Paragraph 2143

In addition, claims 2-5, 7, 9-10, and 18-22 do not describe claim limitations of novel independent claims 1 and 15, as shown above.

Furthermore, there are a few inconsistencies in the Examiner's arguments. For example, regarding claims 9 and 21, there is no indication in Ito et al. that the icon "message page" has anything to do with message tone sounds recited in claims 9 and 21, as wrongfully alleged by the Examiner. The Applicant further amended claims 9 and 21 to add the word "tone" strictly for clarifying this point.

Second, even if only for the sake of argument we assume that Ito et al. teach or suggests all the limitations of claims 2-5, 7, 9-10, and 18-22 (contrary to what is admitted by the Examiner), there is no suggested desirability or motivation, expressed explicitly, implicitly or even hinted at by Ito et al. or generally

available to one of ordinary skill in the art to modify the reference of Ito et al. to arrive at the subject matter of claims 2-5, 7, 9-10, and 18-22 of the present invention (as required by the MPEP Paragraph 2143 referenced above and by the case law). The Federal Circuit Court has several times expressly addressed the issue.

For example, *in re Geiger, supra*, it is stated, in holding that the USPTO "failed to establish a *prima facie* case of obviousness":

"Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984)."

Furthermore, Judge Newman, in her opinion in *In re Lee*, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1433 (Fed Cir. 2002), repeats this fundamental principle:

"When patentability turns on the question of obviousness, the search for and analysis of the prior art includes evidence relevant to the finding of whether there is a teaching, motivation, or suggestion to select and combine the references relied on as evidence of obviousness."

The reference of Ito et al. quoted by the Examiner does not suggest, discuss or even hint about the solution recited in the corresponding claims 2-5, 7, 9-10, and 18-22 of the present invention.

In other words the Examiner failed to show a *prima facie* case of obviousness because he does not show any basis present in the art at the time of the invention for

combining or modifying references (see MPEP paragraphs 2142, 2143 quoted above, and the case law). Therefore, it is highly unlikely that somebody of ordinary skill in the art would have been reasonably expected to modify the reference of Ito et al. quoted by the Examiner at the time of the invention and to find the solution claimed by the Applicant in claims 2-5, 7, 9-10, and 18-22 without the benefit of hindsight.

Moreover, Hahlganss does not provide teaching or suggestion for the reasonable expectation of success by modifying the reference of Hahlganss to find the solution claimed by the Applicant in claims 2-5, 7, 9-10, and 18-22, as required by the MPEP paragraph 2143, quoted above to establish a *prima facie* case of obviousness.

Thus, based on the above remarks, claims 2-5, 7, 9-10, and 18-22 are not obvious under 35 U.S.C. 103(a) as being unpatentable over Ito et al.

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Claims 6 and 17 were rejected under 35 U.S.C. 103(a) as being unpatentable over Ito et al (U.S. Pub 2001/0053692 A-1) in view of Haraguchi (US Patent 6597229 B1).

Regarding claims 6 and 17, these are dependent claims (directly or indirectly) of independent claims 1 and 15. Independent claims 1 and 15 are not unpatentable over Ito et al. in view of Haraguchi, as shown above. Since each of the dependent claims 6 and 17 narrows the scope of the novel and non-obvious independent claims 1 and 15, non-obviousness of claims 1 and 15 will compel non-obviousness of claims 6 and 17.

In addition, similar arguments can be made regarding lack of suggested desirability or motivation, the



reasonable expectation of success, etc. presented by the Examiner, as required by the MPEP paragraph 2143 and case law quoted above to establish a *prima facie* case of obviousness.

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Claim 8 was rejected under 35 U.S.C. 103(a) as being unpatentable over Ito et al (U.S. Pub 2001/0053692 A-1) in view of Kamimura (US Pub, 2002/0094806 A1).

Regarding claim 8, these are dependent claims (directly or indirectly) of independent claims 1 and 15. Independent claims 1 and 15 are not unpatentable over Ito et al. in view of Haraguchi, as shown above. Since the dependent claim 8 narrows the scope of the novel and non-obvious independent claims 1 and 15, non-obviousness of claims 1 and 15 will compel non-obviousness of claim 8.

In addition, similar arguments can be made regarding lack of suggested desirability or motivation, the reasonable expectation of success, etc. presented by the Examiner, as required by the MPEP paragraph 2143 and case law quoted above to establish a *prima facie* case of obviousness.

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The objections and rejections of the Office Action of December 14, 2005 having been obviated by amendment or shown to be inapplicable, withdrawal thereof is requested and passage of claims to issue is solicited.

Respectfully submitted,



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